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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/657,394

09/08/2003

William J. Mertz

1248 P 122

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04/26/2006

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EXAMINER

MOORE, MARGARET G

ART UNIT

PAPER NUMBER

1712

DATE MAILED: 04/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/657,394

Applicant(s)

MERTZ ET AL.

Examiner

Margaret G. Moore

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 to 11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 to 11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

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1. As summarized in paragraph 4 of the previous office action, the Examiner is considering these claims in a product by process manner since she is unable to find a reference that measures silicone extractables. The Examiner presumes that applicants have no objection to this interpretation since they include in their arguments a summary of the process by which the product is made as well as statement of their belief that it is this process which results in the reduced amount of total extractables.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1 to 11 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Leir et al. '356.

The basis for this rejection is consistent with that detailed in the previous office action.

Applicants are of the position that Leir et al. represent a "conventional UV cured silicone based release liner". They also state that a "conventional" release liner is prepared without solvent and without a heating step. Applicants appear to be of the position that the results from a "conventional" release liner provided in the specification are similar or comparable to those of Leir et al. The Examiner does not agree that one can compare the results in the specification of a "conventional" release liner to Leir et al.

Leir et al. exemplify release liners prepared by applying the composition with a volatile organic solvent. The solvent is then allowed to evaporate prior to UV cure. See for instance Examples 1 to 32. Thus all of the advantages of applying the composition in a solvent, as argued by applicants, will be inherently found in the composition of Leir et al. In addition since patentees teach that the solvent is evaporated, the benefits of having the solvent driven off, as argued by applicants, will also be expected to be found. Although the examples showing a solvent do not include heating, solvent evaporation none the less occurs.

Furthermore, in the working examples that show solvent systems, the release coatings are heated after UV curing. It follows that this will have a comparable affect as

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the heating step prior to UV curing; the evaporation of any volatile components remaining in the coating.

Also note that, in the examples that are "solventless" (such as Ex. 33), the silicone composition is applied in combination with a "reactive diluent" (CHVE, described on column 7, lines 11 and on). Such a component is, in effect, an organic solvent since it reduces viscosity and will have the results associated therewith (as described on the bottom of page 3 through page 4 of applicants' results). The examiner notes that applicants' arguments do not place any significance on the type of solvent. The reactive diluent in these examples can be considered an organic solvent. Since heating occurs in these processes, the benefits attributed to heating as described by applicants will also be met. These silicone release liner are prepared by the same or comparable method as those claimed.

Thus the Examiner maintains the position that the release liner in Leir et al. will inherently meet the claimed properties since the processes by which they are prepared are the same or comparable to those by which the claimed release liner are made.

On the other hand, applicants are reminded of the product by process rationale which states that "if the product in the product-by-process claim is the same as *or obvious from* a product of the prior art, the claim is unpatentable even though the prior product was made by a different process".

The Examiner emphasizes "obvious from" because the step of heating to remove the solvent would have been obvious to the skilled artisan in view of the teachings in Leir et al. That is, the skilled artisan would know that heating expedites the evaporation of solvents. Thus if not anticipated, such a step would have been obvious to the skilled artisan in an effort to reduce the time it takes for a solvent to evaporate. If not inherent in the composition of Leir et al., the claimed properties would appear to be inherent in an obvious variation of Leir et al.

For these many reasons the Examiner maintains that the rejection made is proper and that applicants' remarks fail to distinguish or render unobvious the claims over the prior art.

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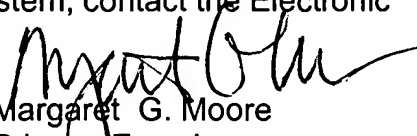
4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret G. Moore whose telephone number is 571-272-1090. The examiner can normally be reached on Monday to Wednesday and Friday, 10am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Margaret G. Moore  
Primary Examiner  
Art Unit 1712

mgm  
4/22/06